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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,962	02/08/2002	Stephen B. Sutherland	WH-11 109-IUS	7929
26123	7590	03/30/2006	EXAMINER	
BORDEN LADNER GERVAIS LLP			LIN, KENNY S	
WORLD EXCHANGE PLAZA				
100 QUEEN STREET SUITE 1100			ART UNIT	
OTTAWA, ON K1P 1J9			PAPER NUMBER	
CANADA			2154	
DATE MAILED: 03/30/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/067,962	SUTHERLAND ET AL.
	Examiner Kenny Lin	Art Unit 2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 December 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 9-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 9-11 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 9-11 are presented for examination. Claims 1-8 and 12-21 are canceled.

Response to Amendment

2. The affidavit filed on 12/22/2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Tornabene et al. (US 2002/0023132) reference.

3. **37 CFR 1.131 (b)** stated that:

The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

4. **MPEP 715.02** stated that:

The 37 CFR 1.131 affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim (such as a species of a claimed genus), in the sense that the claim as a whole reads on it.

5. **MPEP 715.07** stated that:

Exhibits and models must comply with the requirements of 37 CFR 1.91 to be entered into an application file. See also MPEP § 715.07(d). A general allegation that the invention was completed prior to the date of the reference is not sufficient. Ex parte Saunders, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131. 37 CFR 1.131(b) requires that original exhibits of drawings or records, or photocopies thereof, accompany and form part of the affidavit or declaration or their absence satisfactorily explained.

* * *

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

6. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Tornabene et al. reference to either a constructive reduction to practice or an actual reduction to practice. Although the document "Discussion Notes – EPO Website Concepts" attempts to show conception of the claimed invention prior to the effective filing date of the Tornabene reference, the presentation submitted does not clearly establish diligence from a date prior to the date of reduction to practice of the Tornabene reference. Applicants' diligence from the date of July 30, 1999 to the date of reduction to practice of the Tornabene reference is not shown.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Tornabene et al. reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Although the document "Discussion Notes – EPO Website Concepts" and the php3 program codes of Exhibits D, E, F and G attempt to show conception of the whole claimed invention prior to the effective filling date of

Tornabene, the documents fail to show prior conception of **all** of the claimed limitations. The Exhibits fail to show the conception of the claimed limitations of “web server providing each user with an *invitation procedure* for inviting others to access the images controlled by the user, said invitation procedure including *creating an invitation which includes an authorization segment and forwarding the invitation electronically to a designated invitee at a particular address*, said designated invitee *using said invitation to contract the web server and provide access to said images* controlled by the user *in accordance with said authorization segment*” of claim 9 and “any recorded user has *a listing of photo albums and said photo albums include personal photo albums and photo albums which the user and received authorization to share*” of claim 11. Prior date of conception of all of the claimed limitations of the claimed invention to the effective date of the Tornabene reference is not shown.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Tornabene reference. The Exhibits submitted does not show evidence of actual reduction to practice since the quote does not provide evidence to an actual model of the finalized product having each and every function claimed. The php3 program codes of Exhibits D, E, F and G are insufficient to establish a reduction to practice of the invention since the codes require execution and testing on a machine to show proof of a working server. A written description and exemplary sample codes do not constitute an actual reduction to practice.

Applicant has not met the burden of showing prior invention.

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7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. The following terms lack proper antecedence basis:

- i. Claim 9, lines 5 and 8 – “the user”;
- ii. Claim 11, line 3 – “the user” (is this referring to “any recorded user” in line 2?).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Tornabene et al (Tornabene), US 2002/0023132.

11. Tornabene was cited in the previous office action.

12. As per claim 9, Tornabene taught the invention as claimed including a photosharing wide area computer network comprising a web server storing digital images associated with particular users and allowing each particular user to authorize others to access the digital images of the particular user (pp. 0006-0007, 0084, 0091; members sharing data files such as photographs), said web server providing each user with an invitation procedure for inviting others to access the images controlled by the user (pp. 0006, 0012, 0074-0077, 0079-81), said invitation procedure including creating an invitation which includes an authorization segment and forwarding the invitation electronically to a designated invitee at a particular address (pp. 0006, 0046, 0080-0081, 0085, 0094-0096), said designated invitee using said invitation to contact the web server and provide access to said images controlled by the user in accordance with said authorization segment (pp. 0006, 0080-0085, 0091).

13. As per claim 10, Tornabene taught the invention as claimed in claim 9. Tornabene further taught that invitees access said web server using a computer and the internet (pp. 0006-0007, 0012, 0079-82; email, chat, instant message all require the use of computer and the internet).

14. As per claim 11, Tornabene taught the invention as claimed in claim 9. Tornabene further taught that upon contact with the web server any recorded user has a listing of photo albums and said photo albums include personal photo albums and photo albums which the user and received authorization to share (pp. 0006-0007, 0009, 0091).

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (571) 272-3968. The examiner can normally be reached on 8 AM to 5 PM Tue.-Fri. and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksl
March 16, 2006


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